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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,381	02/24/2004	Frederico Wagner	WAGN.005A2	6579
20995	7590	10/04/2005	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			PAIK, STEVE S	
		ART UNIT	PAPER NUMBER	
		2876		

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/785,381	WAGNER ET AL.
	Examiner	Art Unit
	Steven S. Paik	2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 November 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-64 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 1-10 is/are allowed.
 6) Claim(s) 11,12,16,18-24,26,32,33,37,38,41,42,46,47,52,54 and 58-60 is/are rejected.
 7) Claim(s) 13-15,17,25,27-31,34-36,39,40,43-45,48-51,53,55-57 and 61-64 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 24 February 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 12/3/04;7/19/05.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

Response to Amendment

1. Receipt is acknowledged of the Pre-Amendment filed November 15, 2004.

Information Disclosure Statement

2. The information disclosure statement filed 4/19/2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP §609 because the applicant has merely included copies of forms 892 and 1449 that were used in a parent case, with timestamps, serial numbers, and/or examiner's signatures/initials from the case. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP §609.05(a).

Specification

3. The disclosure is objected to because of the following informalities: page 1 of the Specification includes information regarding related applications. It is respectfully requested the blank be updated with corresponding application numbers. Appropriate correction is required.

Claim Objections

4. Claim 38 is objected to because of the following informalities: claim 38 recites "a seventh instruction" in line 2. However, the base claim does not recite first through fifth instruction. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 11, 12, 16, 18-24, 26, 32, 33, 37, 38, 41, 42, 46, 47, 52, 54, and 58-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emmott et al. (US 6,425,487 B1) in view of Krichilsky et al. (US 6,530,518 B1).

Re claims 11, 12, 16, 22-24, 26, 32, 37, 38, 41, 47, 52, 54, and 58-60, Emmott discloses a disposal and provisioning system and a method of selectively providing samples, comprising:
a waste disposal unit (electronic discard unit 32 in Fig. 3), the waste disposal unit including:

a processor/a processing system central processing unit (control unit 12 and col. 3, ll. 15-20 and a computer 35 inherently comprises a CPU);

a scanner (barcode reader 37) coupled to the processor, the scanner configured to scan a code on items deposited in the waste disposal unit (col. 5, ll. 17-20);

an identification database accessible by the CPU (col. 2, ll. 1-9, 18-20 and col. 3, ll. 39-49);

a content database accessible by the CPU (col. 3, ll. 46-49);

the processor performs functions including:

identifying the discarded item by referring to the identification database (col. 2, ll. 1-9, 18-20 and col. 3, ll. 39-49) and if a match is not found within the identification database, by searching over a computer network for a match (col. 5 shows the control unit 12 could modify an inventory of items maintained by software stored on the PC so as to enable the user to take into account the items disposed of when making their next grocery order via the PC. The depository could be connected to a wireless or wired network. This teaching shows the CPU is equipped to maintain a more sophisticated inventory system via a computer network for the purpose of an improved reordering process);

updating the content database to include an entry corresponding to the identified discard item (col. 2, ll. 1-6); and

generating a re-order instruction for replacing the discarded item (col. 2, ll. 6-9).

The electronic discard unit further comprises a user operated bypass control (manually operated foot pedal or the like) which causes at least one discarded item to be deposited in a first receptacle without reference to the at least discarded item identification code, a stored user preference readable by the CPU (As Emmott et al. discloses in column 1, lines 9-14, many householders compile a list of groceries and other domestic purchases at least in part based on

items previously consumed. The previously consumed item reasonably represents a user's preference because the user preferably buys the previously consumed item for a reason such as price, quality, color, size, taste or manufacturer, etc. Therefore, by reading a barcode on a label of the consumed item, the trash-receiving unit of Emmott et al. consequently maintains data that are useful for making decisions involved with reordering such as the size, expiration date and manufacturer. Furthermore, col. 3, ll. 45-46 discloses the control unit 12 determines the waste article 20 formerly contained a specific quantity of vegetable oil, manufactured by a specific manufacture. This may be another important decision factor regarding a reorder period based on the user's preference) that includes a preference related to shopping delivery timing and identifying a preferred supplier, a closure (lid assembly 7) mechanism that supports the discarded item while the at least one input device (barcode reader) obtains the code corresponding to the discarded item and that opens after the at least one input device obtains the code, and a display (14), wherein the CPU executes programmatic software (col. 5, ll. 1-5) to perform the function of displaying a price of the discarded item on the display.

However, Emmott et al. do not explicitly disclosing a step of receiving over a network user specified sample preferences from a first user.

Krichilsky et al. disclose an exemplary main screen that is presented to a user system 18 upon accessing the host system 14. The user system 18 is presented with a number of report buttons 50, 52, 54, 56 and 58. The user can chose a report by a selecting a button using an input peripheral (e.g., mouse, trackball, keyboard) at user system 18. The user can also limit the report through a drop down menu 60 that allows the user to indicate the scope of the orders included in the report. The user may select all orders, orders for a specific product (e.g., Product A as shown

in FIG. 4), orders from a group of products, orders made from a manufacturing location, orders manufactured on a particular line or machine, etc. The user may also select reports for orders of samples of a product. In certain industries (e.g., plastics) samples are sent to customers for testing and analysis. Thus, the reports are not limited to commercial, non-sample orders. Since one may order samples of a product before purchasing a regular size product, he/she would have a chance to try a smaller size of a product without paying a regular price. And the manufacturer may also benefit by collecting product data before manufacturing a massive quantity.

In view of Krichilsky et al.'s teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further employ a method of trying a sample size product in addition to the steps of generating a shopping list of Emmott et al. due to the fact that both a consumer and a manufacturer may benefit as discussed above.

Re claim 18, Emmott et al. in view of Krichilsky et al. disclose the method as recited in rejected claim 16 stated above, further comprising receiving an indication that the first sample has been used from a waste disposal unit (The content and identification of a deposited item is stored and processed by the processing unit.).

Re claim 19, Emmott et al. in view of Krichilsky et al. disclose the method as recited in rejected claim 16 stated above, further comprising:

receiving an indication that at least packaging for the first sample has been deposited in a disposal unit;

causing a query to be presented via the disposal unit to the first user in order to determine if the first user wants to order a non-sample version of the first sample; and receiving a response to the query (col. 3, ll. 60-65).

Re claim 20, Emmott et al. in view of Krichilsky et al. disclose the method as recited in rejected claim 19 stated above, further comprising:

causing at least one query to be presented to the first user in order to determine at least one of a size or a quantity of the non-sample version that the user wants (col. 3, ll. 60-65 and col. 4., ll. 1-5).

Re claim 21, Emmott et al. in view of Krichilsky et al. disclose the method as recited in rejected claim 16 stated above, further comprising receiving information scanned from the first sample by the first user using a scanner (barcode reader 37) coupled to a waste disposal unit (waste disposal system 32).

Re claim 33, Emmott et al. in view of Krichilsky et al. disclose the method as recited in rejected claim 32 stated above, further comprising:

receiving from a networked waste receptacle discard information related to at least a first sample item package disposed of by the user (by the barcode reader and CPU; Emmott et al. in view of Krichilsky et al. the item may be a sample item or non-sample item.);

causing an order form for a regular version (regular version or replacing a previously discarded item) of the first sample item to be presented to the user; and

receiving an order from the user for the non-sample version of the item (col. 3, ll. 60+).

Re claim 42, Emmott et al. in view of Krichilsky et al. disclose the method as recited in rejected claim 37 stated above, wherein the scanning system further comprises a touch screen unit configured to display information to the user and to receive user inputs (col. 3 line 22 disclose an LCD as an example. Emmott et al. further disclose that other types of display could

be used. Touch screen type allows a user to respond easily and instantly from the output he/she receives from his or her previous input selection.).

Re claim 46, Emmott et al. in view of Krichilsky et al. disclose the method as recited in rejected claim 37 stated above, wherein the scanner includes at least one of a barcode scanner (barcode scanner 37) or a radio frequency scanner.

Allowable Subject Matter

8. Claims 1-10 are allowable.

9. Claims 13-15, 17, 25, 27-31, 34-36, 39, 40, 43-45, 48-51, 53, 55-57, and 61-64 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter: none of the cited prior art of the record discloses, teaches, or fairly suggests the claimed disposal and provisioning system comprising, among other things, a set of instructions for a user to control replacement of a discarded item.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 571-272-2404. The examiner can normally be reached on Monday - Friday 5:30a-2:00p (Maxi-Flex*).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2876

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven S. Paik
Primary Examiner
Art Unit 2876

ssp